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Appl. No.: 10/524,710

Amdt. Dated November 21, 2007

Response to Office Action Mailed August 24, 2007

AMENDMENTS TO THE DRAWINGS:

Please amend the drawings by replacing original sheet 3 containing Figs. 5 and 6(A)-(B) with the enclosed Replacement Sheet 3 containing amended Fig. 5 and original Figs. 6(A)-(B).

No new matter is added.

Appendix attached at end of this paper: Replacement Drawing Sheet 3.

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REMARKS:

Applicant appreciates the time and care the examiner has taken in examining the application. Applicant requests reconsideration of the final rejection of the claims, and states the following in support.

On the Drawings. In the enclosed amendment, no new matter is added. Fig. 5 has been amended to include the legend PRIOR ART. In view of the drawing amendment and enclosed replacement sheet 3, it is submitted that the objection to the drawings should now be withdrawn.

On the Claims. In the enclosed amendment, claim 1 has been amended to incorporate the limitations of claim 3, which has been cancelled. Claim 4 is amended to depend from claim 1 rather than claim 3. No new matter is added. Claims 1 and 4 are the only pending claims.

On the Rejection. It is respectfully submitted that the examiner has failed to establish a prima facie case of anticipation with respect to claim 1, which now incorporates exactly the limitations of claim 3 prior to its cancellation. The examiner relies upon Fig. 5 of the instant written description as providing the features of claim 3. The examiner states (Office action, p. 4):

Regarding claim 3, the admitted prior art discloses a middle projection (above 24 in fig. 5) provided on the blade edge between the projections (25) of the second pair, and which is fully capable of performing the function of 'to hold the crown of the staple when the pair of leg portions pass through the bundle of papers.'

This finding is traversed. There is no middle projection on the blade edge in Fig. 5. Above reference numeral 24 in Fig. 5 is the staple, and then, above that, is the blade edge, with no middle projection therein. Rather, the middle portion of the blade edge is a straight edge that is straddled by the pairs of projections positioned closer to the corners of the staple.

Thus, no prima facie case of obviousness is established for the reason, among others, that the cited prior art fails to disclose *a middle projection provided on the blade edge between the projections of said second pair, to hold the crown of the staple when the pair of leg portions pass through the bundle of papers*. For the sake of clarity, it is reiterated that the middle projection of claim 3 refers to the central projection designated as reference numeral 9 in Fig. 1 and as reference numeral 10 in Fig. 2. "Middle" has the ordinary dictionary meaning of:

middle [mid'l], adj. 1. *equally distant from the extremes or outer limits; central: 'the middle part of a room.'*

Random House Webster's College Dictionary, p. 839 (Random House, New York City) (2d rev. 2000).

It is further respectfully submitted that no prima facie case of obviousness has been established, to the extent that the examiner's rejection of claim 3 relies on the examiner's dismissal of numerous features of claim 1 as merely "...functional and intended use statements which are fully capable of being performed by the admitted prior art structure shown in fig. 5 and described at pages 1 and 2 of the present application." (Office action, p. 4). The features listed by the examiner are positively claimed features of the device, and to the extent that their descriptions rely on functional language, they are of such nature as fairly to limit the structure claimed in such a manner as to distinguish over the prior art. Functional limitations can be afforded patentable weight in examinations for anticipation. *See, e.g., In re Ludtke*, 169 USPQ 563, 566 (CCPA 1971); *In re Atwood*, 148 USPQ 203, 210 (CCPA 1966); and *In re Bisley*, 94 USPQ 80, 83 (CCPA 1952). In some of the features dismissed by the examiner as functional, it

is noted that some of the functional language serves to distinguish among the relative features of the device, rather than simply to define the features by their function.

For the sake of brevity, arguments in all prior responses to office actions in this application are hereby incorporated by reference in their entirety.

It is respectfully submitted that the application is in condition for prompt allowance and that all of the objections, rejections and requirements raised in the Office action have been met. Early, favorable treatment of this application is requested.

The examiner is encouraged to telephone the undersigned with any questions or comments so that efforts may be made to resolve any remaining issues.

The Commissioner is hereby authorized to charge any necessary fees, or credit any overpayment, associated with this communication, including fees for any necessary extension of time under 37 CFR §1.136(a) for filing this communication, which extension is hereby requested, to our Deposit Account No. 50-0305 of Chapman and Cutler LLP.

Respectfully submitted,

By: 

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CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. § 1.8

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I hereby certify that the attached correspondence, namely: Response to Office Action, was transmitted by facsimile on the date listed above, to the U.S. Patent Office at the facsimile number listed above, under 37 C.F.R. § 1.8.

Signature: 

Typed Name of Person Signing this Certificate: Jane S. Berman

Date of Signature: November 21, 2007